



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,489	03/08/2001	Isao Iwaguchi	1081.1111/JDH	2199

21171 7590 10/19/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,489

Applicant(s)

IWAGUCHI ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,9,11 and 16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3,9,11 and 16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the RCE filed on 07 August 2006 and amendment filed on 07 October 2006.
2. Claims 1, 6-8, 14-15, and 20-21 have been cancelled.
3. Claims 3, 9, 11, and 16 have been amended.
4. Claims 3, 9, 11, and 16 are currently pending and have been examined.

RESPONSE TO ARGUMENTS

5. Applicant's arguments received on 07 October 2006 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

Applicant argues that the passages cited by the Examiner from the applicant's background overreach, and do not disclose the automated features of the claimed invention. *In re Venner* 120 USPQ 192, 1994 (CCPA 1958) states "...it is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result." Since the Applicant in the background discloses the manual function of checking out using a POS terminal and inherently settling the purchase by using a "submit" or "enter" key to finish the transaction, and then further discloses that these well-known

Art Unit: 3621

steps are automated in the claimed invention, the applicant limitations are deemed obvious in view of the prior art of reference in combination with the teaching of the *Venner* decision. In the present case, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification, and has interpreted the prior art of reference reads on the claim language.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 9, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 6,487,540 B1) in view of Komai (US 6,625,579 B1), and further in view of Applicant's own admissions.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Art Unit: 3621

Claims 3, 9, 11, and 16:

With regard to the limitations of:

- *calculating goods settlement information from goods information of goods purchased by a user and processing a settlement;*
- *sending goods purchase information, including said goods settlement information, to a mobile terminal of said user, and storing the goods purchase information in said mobile terminal to communicate with a processing device of said user,*
- *reading the goods information for the goods purchased by said user using a reader on said settlement device;*
- *calculating the goods settlement information from said read goods information on a register terminal of said settlement device and processing the settlement;*

See at least Column 2, lines 11-20; column 3, lines 19-26, lines 31-36, lines 45-55; and column 5, lines 47-51. The use of the Wireless Application Protocol (WAP) in this case reads on Applicants use of a prompt between units to signal transfer of data.

Smith does not specifically disclose a settlement key or a receipt issue key. Komai, however, in at least column 6, line 16 as well as column 11, line 51 does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Smith and Komai because each reference common POS architectures known at the time of the instant invention.

With regard to the limitation of wherein said sending of the goods purchase information comprises sending said goods purchase information to said mobile terminal from said register terminal in response to a prompt from a settlement key of said goods settlement information in said register terminal., Applicant, in the background of the specification, discloses that the processes between users and POS terminals are already well-known and widely used during a transaction.

Art Unit: 3621

With regard to the limitations of:

- *requesting said goods purchase information from said reader to said register terminal.*
- *receiving said goods purchase information from said register terminal to said reader.*
- *sending said received goods purchase information to said terminal from said reader.*
- *sending a send enable signal to said mobile terminal from said reader when said reader reads a barcode of said goods;*
- *transmitting a received request to said reader from said register terminal in response to said send enable signal, and*
- *requesting said goods purchase information from said reader to said register terminal in response to said receive request;*

See at least Column 2, lines 11-20; column 3, lines 19-26, lines 31-36, lines 45-55; and column 5, lines 47-51. The use of the Wireless Application Protocol (WAP) in this case reads on Applicants use of a prompt between units to signal transfer of data. In addition, see the inclusion of the Applicant's background information regarding POS terminals.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 3, 9, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Swartz et al. (US 2003/0132298 A1).

Claims 3, 9, 11, and 16 :

Swartz discloses a self-checkout system that utilizes bar code readers to tally purchase items at a merchant shop and then uses a PDA to permit the checkout of the customer with the items, the transaction having been settled and complete.

Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

JAMES A. REAGAN

Primary Examiner

Art Unit 3621

26 September 2006

JAMES A. REAGAN
PRIMARY EXAMINER

